

Remarks

Claims 47 and 54-56 are cancelled without prejudice. Claims 48 and 58-61 are amended so that they do not depend from a cancelled claim. Claims 22-45, 48-53 and 58-63 are pending in the captioned application.

1. The Office Action stated that claims 22-45 are allowed.
2. The Office Action stated that claims 48-53 and 58-63 are objected to as depending upon a rejected base claim, but would be allowable if rewritten in independent form. Each of claims 48, 58 and 59 previously depended from now cancelled claim 47, and each has been rewritten in independent form including all of the limitations of the base claim and any intervening claims. Each of claims 49 and 50 depend from now-independent claim 48. Claim 51 is an independent claim. Each of claims 52 and 53 depend from independent claim 53. Each of claims 60 and 61 have been amended to depend from allowed claim 43. Claim 62 is an independent claim. Claim 63 depends from independent claim 62.

3. The Office Action rejected claims 47 and 54-56 under 35 U.S.C. §135(b)(2) as having been made in the captioned application more than one year after claims 6 and 13-15 of application Ser. No. 09/817,268 (claiming a priority date of 30 June 1999) were published on 25 October 2001. The applicants respectfully traverse the rejection for the reasons stated in the 5 November 2009 reply to the then pending office action, and for the independent reasons stated in the Reasons for Pre-Appeal Brief Review (received in the PTO on 21 January 2009) in connection with the office action pending at that time. Nonetheless, in an effort to progress in prosecution of an application that has been pending for nearly nine years, the rejected claims are cancelled without prejudice. As discussed above, claims 48 and 58-61 are amended so that they do not depend from a cancelled claim, and these amendments do not affect the explanations in the charts included with the 5 November 2009 reply to the then pending office action.

4. As in the previous office action, the present Office Action objected to the applicants' April 2004 request for an interference for alleged failure to comply with various provisions of Subpart E of Part 41 of Title 37 of the Code of Federal Regulations that did not become effective until September 2004, specifically provisions of 37 CFR §§41.202(a). The undersigned does not understand those provisions to have been retroactively applicable to requests that already had been submitted, as is the case in the captioned application. Consequently, the objection should be overcome for that reason alone.

Nonetheless, in the interest of expediting prosecution of the captioned application, the applicants substantively responded to the objection and complied with the provisions of 37 CFR §41.202(a) in the 5 November 2009 reply to the previous office action.

a. In any collection of proposed counts, each of the proposed counts should be patentably distinguishable from the other proposed counts in that collection. A claim corresponds with a proposed count if it is not patentably distinguishable from that proposed count, so it should correspond with only one proposed count in that collection of proposed counts.

The applicants previously had proposed a single *broad* count and had indicated why each of the claims in the captioned application and in the patents corresponded with that proposed count. In an effort to address to the PTO's objections in the previous office action, the applicants proposed the *narrower* counts in Attachment A of the 5 November 2009 reply. Each additional proposed count includes different or additional limitations that distinguish it from the preceding proposed counts. Attachment B of the 5 November 2009 reply showed how each of the claims corresponds to one of those narrower proposed counts and, accordingly, include the limitations

that distinguish that proposed count from the other proposed counts. The present Office Action again objected – apparently because the proposed counts are now too narrow.

A count is a description of interfering subject matter. 37 CFR §41.201. It is the PTO, and not the applicants, who decides what the count(s) is (are). In this case, Attachment A of the 5 November 2009 Reply proposed counts. Attachment B showed the claims that correspond to each of the proposed counts. With respect to each proposed count, Attachment C compared at least one claim of each party corresponding to that proposed count. “The examiner need not agree with the applicant’s suggestion.” MPEP §2304.02(b).

b. Finally, the 5 November 2009 reply stated that Attachment D was submitted to comply with 37 CFR §41.202(a)(6). For each constructive reduction to practice (a copy of the international application was filed as each of the U.S. applications), Attachment D shows where the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter. Therefore, it is difficult to understand paragraph 6 on page 3 of the Office Action, that asserted: “[w]ith regard to the attachment D, the captioned application (and in all of its ancestor applications going back to the corresponding international application PCT/NZ95/00106) and in foreign priority application NZ 272778 have no bearing on the earliest effective US filing date.”

First, the captioned application was filed on 18 December 2001. It is a continuation of Ser. No. 09/713,614, filed 15 November 2000 and issued as US 6,343,924 on 12 December 2002; which was a continuation of Ser. No. 08/817,445, with a §371(c) date of 30 April 1997 and issued as US 6,198,458 on 6 March 2001; which was a U.S. national stage application of PCT/NZ95/00106, filed 16 October 1995. Each application in this series of co-pending applications has an identical disclosure and claims priority through each of its ancestor

applications. Pursuant to 35 U.S.C. §120 (“an application previously filed in the United States, *or as provided by Section 363 of this title*” [emphasis added]), the earliest effective U.S. filing date is the 16 October 1995 filing date of the ancestor international application.

Second, “[e]arliest constructive reduction to practice means the first constructive reduction to practice that has been continuously disclosed through a chain of patent applications including in the involved application or patent. For the chain to be continuous, each subsequent application must have been co-pending under 35 U.S.C. 120 or 121 or timely filed under 35 U.S.C. 119 or 365(a).” 37 CFR §41.201. As indicated on page 4 of the 5 November 2009 reply, Attachment D shows where each proposed count is disclosed in the captioned application and in each of its ancestor applications going back to the international application (each having an identical disclosure as filed), and in a foreign priority application that was filed in New Zealand less than a year before the international application was filed. The middle column of Attachment D is labelled PCT/NZ05/00106, and the citations to the captioned application (and to intervening applications) are the same since a photocopy of the international application was filed as the captioned application (and as intervening applications).

The understanding of the undersigned is that the purpose of §41.202(a)(6) is to identify where the proposed interfering subject matter is disclosed in the applications on which one is relying for priority. Attachment D of the 5 November 2009 reply accomplishes that and complies with §41.202(a)(6).

The objection should be overcome in view of the foregoing.

The Applicants submit that the claims are in condition for allowance, and respectfully request reconsideration and a determination that the claims are allowable. If a telephone interview or an in-person interview would expedite prosecution of the captioned application, the applicants request that the undersigned be contacted to schedule such an interview.

Respectfully submitted,



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